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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,328	02/12/2004	Saad N. Nemeh	5014	4918

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/777,328

Applicant(s)

NEMEH ET AL.

Examiner

Michael A. Marcheschi

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1755

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112 first and second paragraph rejections.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13 and 20-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Michael A. Marcheschi
Primary Examiner
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ATTACHMENT TO THE ADVISORY

All of the previous art rejections apply in this advisory action.

With respect to the rejection based on *Mixon*, applicants argue that this reference does not teach (1) the use of Chinese kaolin, but rather uses Georgia kaolin (see column 5, lines 10). Although column 5, lines 10 defines Georgia kaolin, the reference uses “such as” and “such as” is not indicative of this being the only clay that can be processed. The phrase “such as” can be viewed as an example, thus the reference is not limited to this specific kaolin. In addition, claim 1 does not define any type of kaolin, thus this claim broadly reads on processing any type of kaolin and is not limited to Georgia kaolin as argued by applicants.

Applicants state that there are at least two differences between *Mixon* and the instant claims.

The first difference being that different kaolin sources provide kaolin clays having differing chemical compositions. The examiner acknowledges this, however, although differences might exist, this argument does not clearly rebut, in terms of evidence, the examiners position of obvious established in the previous office action (that the processing of Chinese kaolin is obvious because (1) one skilled in the art would have appreciated that **any** type of kaolin can be processed in this manner, (2) irrespective of what the material is called, the method of forming it is the same and (3) *Mixon, Jr.* teaches processing of kaolin, in general, (see column 1, lines 6-20-no limitation placed on the kaolin type) and therefore this reads on and makes obvious the processing of any type kaolin clay because the reference does not limit the clay to a specific type). Applicants also argue that there is not teaching on how to modify the process to

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increase aims (1), (2) and (3) (as defined on page 8, lines 16-18 of the amendment) and to increase the aims at lower calcinations temperatures. The instant claims are not directed to these aims, thus this argument is based on limitations not claimed. In addition, the calcinations temperature, as outlined in the rejection, is the same as the claimed temperature.

The second difference being the multiple pulverization steps and sequence of steps. Applicants provide comments to rebut the examiners position previously defined, however, these comments do not clearly rebut, in terms of evidence, the examiners position of obvious established in the previous office action. Applicants provide no comparative evidence that established criticality for the claimed sequence (reference teaches that multiple pulverization can take place), thus no distinction is seen to exist.

Applicants also state that another major factor is decreasing the amount of organic/carbon impurities and state that pulverization before calcination “likely” exposes more carbon/inorganic compounds to oxygen wherein such compounds are oxidized and vaporized thus allowing the calcinations process to proceed more effectively. The argument is based on a “likely” analysis and “likely” does not establish that this results definitely takes place, thus any argument on a “likely” aspect does not provide sufficient evidence of criticality absent a clear comparison of the claimed process with the process of the reference. Applicants also state that the reference does not teach that multiple pulverization will results in increased brightness. The claim does not define this and even if it did, applicants show no evidence to the contrary. Applicants also refer to page 8, lines 11-13 that defined that multiple pulverization steps is better than one. The examiner acknowledges this but the reference uses multiple pulverization steps (see column 8, line 20.

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With respect to the rejection based on *Mixon and Maxwell*. Applicants have not addressed the examiner reasons for combining. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). However, all arguments above are incorporated herein by reference.

With respect to the rejection based on Fanselow, applicants first argument is based on the reference does teaching Chinese kaolin. The examiner acknowledges this, however, this aspect is obvious because claim 1 of the reference does not define any type of kaolin, thus this claim broadly reads on any type of kaolin material and is not limited to Georgia. Although column 4, lines 23-25 defines Georgia kaolin, the reference uses the limitation "by way of an example" and this limitation is not indicative of this being the only clay in the scope of the reference. It is merely defining an example. As a further point, kaolin occurs in nature in numerous areas and the processing of one specific type of kaolin to have the desired properties of conventional kaolin clays is clearly within the scope of the skilled artisan in order to obtain a specific kaolin having desirable properties as paper fillers. Applicants have not clearly establish the position of patentability over this reference.

Applicants also argue that the way in which the kaolin is produced, in terms of its starting material. The patentability of a claim is viewed in terms of the final product. Since the starting material is calcined, the starting clay is irrelevant to the patentability of the final product. As can be seen, the reference clearly teaches a final kaolin clay that has a size, brightness and oil absorption that reads on the claimed characteristics. Even if one was to consider the starting material, the instant claim state that the starting material has a size of at least 90% being 75

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microns or less (applicants argument using the value of about 75 microns only is not clear because the claims states 75 microns or less) and from 0.01-90% being 2 microns or less. The broad interpretation of this starting material is that substantially all of the particle can be less than 5 microns and 50 percent are finer than 1 micron. This is apparent because the claims do not define a lower size limit. In view of this, the starting material of the reference, in terms of its sizes, reads on the starting material of the instant claims, in terms of its size. The only difference being the source of the kaolin which is obvious. Applicants also make a statement with respect to the case law applied (product by process), in that this applies to only products that are the same. As clearly established above, the products are the same in view of the obviousness established above, thus the case law is applicable and applicant have not shown criticality establishing otherwise.